

REMARKS

By this Reply, claims 11, 13, and 22 have been amended. Accordingly, claims 1-27 remain pending in this application. No new matter has been introduced by this Reply.

In the outstanding Office Action, claims 1-27 were rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; claim 13 was rejected under 35 U.S.C. § 112, second paragraph for lack of antecedent basis; claims 1, 2, 4, 5, 7, 10, 12, 18-22, and 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,106,086 to Acosta ("Acosta"); claims 1-5, 7, 9, 10, and 17-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,319,158 to Cheng ("Cheng"); and claims 1-4, 6, 8-11, and 13-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,096,194 to Yong et al. ("Yong") in view of Acosta.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Independent claim 1 recites, *inter alia*, "without substantially coupling the strings with each other." On page 2 of the Office Action, it is asserted that independent claim 1 is indefinite due to the recitation of "substantially coupling," because "it is not clear what criterion exists to determine what substantially couples and what does not substantially couple." Applicant respectfully disagrees. It is a fundamental principle in 35 U.S.C. § 112, second paragraph that Applicant may be his or her own lexicographer. See M.P.E.P. 2173.01. Further, relative terminology, including use of the word "substantially" in the claims, is acceptable (i.e., definite) if one of ordinary skill in the art

would understand what is claimed, in light of the specification. See Id. at 2173.05(b). Applicant submits that one of ordinary skill would understand the meaning of “without substantially coupling” in light of Applicant’s specification, since the specification clearly describes and provides examples of the difference between dampening devices that couple strings, and Applicant’s dampening device, which is fixed to strings “without substantially coupling” the strings. See Specification, page 2, lines 1 and 15-17. The phrase “without substantially coupling” emphasizes that there is basically no coupling of the strings. Furthermore, one of ordinary skill would also understand the meaning of “without substantially coupling” by observing the relationship between Applicant’s dampening device and the racket strings in FIGS. 2a-6b of Applicant’s specification. Thus, since Applicant may act as his or her own lexicographer, may use relative terminology (including the word “substantially”), and has provided sufficient descriptions in Applicant’s specification that would allow for one of ordinary skill to understand the meaning of “without substantially coupling,” Applicant submits that independent claim 1 is definite, and requests reconsideration and withdrawal of the indefiniteness rejection.

Claims 2-27 depend from independent claim 1, and are definite for at least the reasons stated above that independent claim 1 is definite.

With regard to the rejection of claim 13 under 35 U.S.C. § 112, second paragraph, Applicant has amended claim 13 by changing its dependency, thus providing antecedent basis for the phrase “the mechanical closure.” Similar action has been taken to provide antecedent basis for the phrase “the mechanical closure” in claim 11. In light of these amendments, Applicant requests withdrawal of the indefiniteness rejection of claim 13.

Rejections Under 35 U.S.C. § 102(b)

Applicant respectfully traverses the rejection of claims 1, 2, 4, 5, 7, 10, 12, 18-22, and 24 under 35 U.S.C. § 102(b) as being anticipated by Acosta. Applicant submits that Acosta fails to anticipate the claims because Acosta fails to teach or suggest each of the limitations recited by the claims.

Independent claim 1 recites, *inter alia*, “a base body . . . and a connector formed such that the dampening device can be fixed to at least one longitudinal string of a ball game racket without substantially coupling the strings with each other.” In contrast, Acosta discloses a vibration dampener for rackets including a vibration dampener D made of two pieces D1 and D2, where “the two pieces are pressed tightly towards each other to cause the pressure-sensitive adhesive material to adhere together and thereby anchor the two pieces as an integral vibration dampening unit upon the strings” (emphasis added). Acosta, column 3, lines 10-15. Further, FIG. 6 of Acosta provides additional evidence of substantial coupling of strings 21 and 22 by showing that vibration dampener D tightly encloses strings 21 and 22. Since Acosta discloses that vibration dampener D is anchored onto and substantially couples strings 21 and 22, Acosta fails to teach or suggest, “a base body . . . and a connector formed such that the dampening device can be fixed to at least one longitudinal string of a ball game racket without substantially coupling the strings with each other.” Thus, Acosta cannot anticipate independent claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of independent claim 1, and requests the timely allowance thereof.

Claims 2, 4, 5, 7, 10, 12, 18-22, and 24, each depend from independent claim 1, and are allowable for at least the reasons stated above that independent claim 1 is allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

Applicant respectfully traverses the rejection of claims 1-5, 7, 9, 10, and 17-24 under 35 U.S.C. § 102(b) as being anticipated by Cheng. Applicant submits that Cheng fails to anticipate the claims because Cheng fails to teach or suggest each of the recited limitations.

Independent claim 1 recites, *inter alia*, “a base body . . . and a connector formed such that the dampening device can be fixed to at least one longitudinal string . . . without substantially coupling the strings with each other.” Cheng fails to teach or suggest all of these features. Cheng discloses, in a first embodiment, a racket 10 having a pair of damping strips 36 and 38 adhesively secured to sidewalls 40 and 42 of an elongated slot 34. See Cheng, column 3, lines 1-15; and FIGS. 2-4. Damping strips 36 and 38 are fixed to sidewalls 40 and 42 of racket 10, not to strings 12. In a second embodiment, Cheng discloses an insert 137 that substantially fills an elongated slot 134 in a racket 100, creating a force fit between strings 12 and insert 137. See Cheng, column 3, lines 25-30; and FIGS. 5-7. In this second embodiment, strings 12 are substantially coupled to each other by insert 137, due to insert 137 being tightly enclosed around strings 12. Thus, since the first embodiment in Cheng is deficient in that it uses damping strips 36 and 38 fixed to sidewalls 40 and 42 rather than to strings 12, and the second embodiment in Cheng is deficient in that it uses insert 137 to

substantially couple strings 12 to each other, Cheng fails to teach or suggest, “a base body . . . and a connector formed such that the dampening device can be fixed to at least one longitudinal string . . . without substantially coupling the strings with each other,” as recited by independent claim 1.

Claims 2-5, 7, 9, 10, and 17-24, each depend from independent claim 1, and are allowable for at least the reasons stated above that independent claim 1 is allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-4, 6, 8-11, and 13-27 under 35 U.S.C. § 103(a) as being unpatentable over Yong in view of Acosta. Applicant submits that the Office Action fails to establish the *prima facie* case of obviousness required to reject these claims.

Independent claim 1 recites, *inter alia*, “a base body made of foam material and a connector formed such that the dampening device can be fixed to at least one longitudinal string of a ball game racket without substantially coupling the strings with each other.” On page 4 of the Office Action, it is asserted that Yong discloses the features recited in independent claim 1 except for the foam material. Applicant respectfully disagrees, and submits that Yong is also deficient in other ways.

Yong discloses a rubber flexible strap 10 that is interwoven through strings 34, flexible strap 10 having ribs 18 and 22 that provide stops for locating flexible strap 10 in a positive manner on strings 34, and a clip 38 for securing an elastic, rubber, or rubber-like flexible strap 10 in place on strings 34. See Yong, column 3, lines 1-15, 35-41,

and 65-67; and column 4, lines 1 and 6-14. The interweaving of the elastic, rubber, or rubber-like flexible strap 10 through and around strings 34, suggests that flexible strap 10 substantially couples strings 34 to each other. Thus, Yong fails to teach or suggest, "a connector formed such that the dampening device can be fixed to at least one longitudinal string of a ball game racket without substantially coupling the strings with each other." Acosta fails to remedy this deficiency in Yong, nor is Acosta cited for such a purpose. Whether taken alone or in combination, Young and Acosta fail to teach or suggest each of the limitations in independent claim 1, and as such, cannot be used to establish a *prima facie* case of obviousness in the manner suggested in the Office Action.

Further, Yong also fails to teach or suggest a foam material. On page of the Office Action, it is asserted that "although Yong does not explicitly describe a foam material, it would have been obvious to make the Yong dampener from a foam material in view of Acosta." Applicant respectfully disagrees with this assertion. Yong discloses flexible strap 10, which is made of an elastic material, such as rubber or a rubber-like material, allowing flexible strap 10 to be interwoven through strings 34 to dampen vibrations. See Yong, column 2, line 68; and column 3, lines 1-15. Modifying rubber or rubber-like flexible strap 10 to be made of the material taught by Acosta would not have been obvious. Acosta does not disclose an elastic, rubber, or rubber-like material, but rather, discloses use of foam 14. Modifying flexible strap 10 of Yong to be made of foam 14 of Acosta would change the principle of operation of flexible strap 10, since flexible strap 10 requires the use of elastic, rubber, or rubber-like materials to allow interweaving and vibration dampening.

Furthermore, if flexible strap 10 and ribs 24 of Yong was modified to be made of foam 14, which is shown in Acosta as being soft and conforming (notice how foam 14 conforms to shape of strings 20 and 22 in FIG. 6 of Acosta), rather than elastic and unyielding as in Yong (notice that in Yong, strings 34 do not deform surfaces of flexible strap 10), ribs 24 of Yong could no longer act as stops to hold flexible strap 10 on strings 34, and instead would give way under pressure from strings 34 just as foam 14 gives way to strings 20 and 22 in Acosta. Without elastic, rubber, or rubber-like stops 24, flexible strap 10 could not be secured on strings 34 in the same manner. Additionally, Acosta teaches that foam 14 substantially couples strings 20 and 22, which is also contrary to what is being claimed.

Since modifying Yong with Acosta in the manner suggested in the Office Action would render Yong unsatisfactory for its intended purpose, and would change the principle of operation of Yong, there is no suggestion or motivation to combine Yong with Acosta, and a *prima facie* case of obviousness has not been established. See M.P.E.P. 2143. Accordingly, Applicant requests reconsideration and withdrawal of the rejection of independent claim 1, and allowance thereof.

Claims 2-4, 6, 8-11, and 13-27, each depend from independent claim 1, and are allowable for at least the reasons stated above that independent claim 1 is allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

Also, Applicant respectfully traverses the taking of Official Notice with respect to the rejection of claims 13 and 26, and request, should the current rejection be maintained, that the Examiner provide evidence to support the assertion that

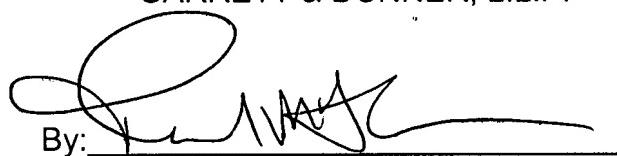
substituting clips with hook and loop fasteners for attaching parts of vibration dampening devices would have been obvious to one of ordinary skill in the art.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: _____

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Dated: June 29, 2007